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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,038	09/20/2005	Erich Fuderer	566/42764	4655
23646 7590 08/23/2007 BARNES & THORNBURG LLP 750-17TH STREET NW SUITE 900 WASHINGTON, DC 20006-4675			EXAMINER RASHID, MAHBUBUR	
			ART UNIT 3683	PAPER NUMBER
			MAIL DATE 08/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/510,038

Applicant(s)

FUDERER ET AL.

Examiner

Mahbubur Rashid

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-22 is/are rejected.
- 7) ☒ Claim(s) 4, 10, 12-16 and 18-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 06/07/2007, 10/26/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Information Disclosure Statement*

1. An information disclosure statement (IDS) was submitted on 06/07/2007, 10/26/2005. Accordingly, the examiner has considered the information disclosure statement, see attached 1449.

### *Double Patenting*

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

**Claims 2-22** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-20 of copending Application No. 10/510037. Although the conflicting claims are not identical, they are not patentably distinct from each other because

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Objections***

3. The following claims are objected:

**Claim 4**, from "by means of" to the end of the claim is not clear and it is confusing.

**Claim 10**, "another stop position is formed by a screwing end position" – is not clear and it is confusing.

**Claim 12**, the entire claim is not clear and it is very confusing.

**Claim 10**, "the other screw part" in line 5 – is not clear which screw part the applicant is referring to.

**Claim 13**, "the other screw part" in line 4 – is not clear which screw part the applicant is referring to.

**Claim 14**, " the other screw part " in line 2 – is not clear which screw part the applicant is referring to.

**Claim 15**, " the other screw part " in line 2 – is not clear which screw part the applicant is referring to.

**Claim 16**, " the other screw part " in line 4 – is not clear which screw part the applicant is referring to.

**Claim 18**, " the other screw part " in line 2 – is not clear which screw part the applicant is referring to.

**Claim 19**, " the other screw part " in line 3 – is not clear which screw part the applicant is referring to.

**Claim 20**, " the other screw part " in line 4 – is not clear which screw part the applicant is referring to.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 10** recites the limitation "the stop" in line 5. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 22, 2, 3, 13, 19 and 20** are rejected under 35 U.S.C. 102(b) as being anticipated by Blosch et al. (US 6,012,556).

Regarding **claim 22**, Blosch discloses a brake application system (fig. 1, (10)) for vehicles, particularly for rail vehicles, comprising:

a wear adjuster (fig. 1, (48), (50)) which is constructed as a brake actuator (10);

a screw drive of the wear adjuster having a threaded spindle (56) and a nut (60)

which can be screwed thereto as the screw parts; and

at least one of the screw parts ((56) and (60)) is electrically driven for the wear adjusting (col. 3, 61-63).

**Re-claims 2 and 3**, see an electric drive unit (electric motor (fig. 1, (50)), gearing (fig. 1, (74), (64), (52), (52') and (52'')) and electrically driven screw part (fig. 1, (56), (60)).

**Re-claim 13**, see the other screw part (fig. 1, (56), (60)) is held in place during the driving of the one screw part (col. 3, 61-63; col. 4, 63-67).

**Re-claim 19**, see a threaded spindle (fig. 1, (56)) and a nut (fig. 1, (60)).

**Re-claim 20**, see spring (fig. 2, (70); col. 4, 16-25).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. **Claims 2-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfsteiner et al. (US 6,722,477 B1) in view of Brooks (US 5,246,091) or Nadas et al. (US 4,431,089).

Regarding **claims 2-22**, Wolfsteiner discloses all claimed elements but fails to distinctly disclose clutch arrangement. However Brooks (US 5,246,091) (see clutch arrangement in figure 2, (110), (78)) and Nadas et al. arrangement at 24 clearly teach known alternative clutch arrangements for linear type brake actuators. Either of these could be substituted for the nut and spindle arrangement of Wolfsteiner simply as an obvious alternative equivalent arrangement of known mechanical parts. Consequently it would have been obvious to have substituted one well known type of gear/spindle/nut and clutching arrangement for another simply dependent upon such well known obvious engineering design considerations as weight, space, and energy considerations and effectiveness of braking action according to application specifics.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mahbubur Rashid whose telephone number is (571) 272-7218. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on (571) 272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mhr

DEVON C. KRANICH  
PATENT EXAMINER  
*Devon Kranich*  
8/20/01